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10/03/2003

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,455

Applicant(s)

KRAFT ET AL.

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Requirements for Information

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (i) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is

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information used in drafting the present operation including information related to the field of endeavor or business practices used by applicants' professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use. Since the application is filed as a large entity status, along with the fact that the assignee has other pending applications and/or patented inventions closely related to the claimed invention and an information disclosure statement has been filed without relating to those other more relevant pending applications and patented inventions, it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination may be performed by the Office.

Specification

The specification is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-26 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention is an abstract idea, which can be performed without interaction of a physical structure. The independently claimed steps analyzing, determining, and selectively displaying do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. Examiner considers the claimed analyzing, determining, and selectively displaying merely a patentable equivalent to a person analyzing, determining, and selectively displaying, or other equivalent terms. The claimed recitation of displaying can be broadly construed to facial expression, such as facial expressions commonly use in the field of shock advertising or the field of sympathy advertising. The recited analyzing, determining, and selectively displaying does not limit the claimed invention to a machine or mechanical process and can be broadly interpreted to be purely non statutory subject matter under this statute. Claims reciting those steps can be performed by interpersonal communications such that the claimed steps can be performed without a physical structure or mechanical object. Because the independently claimed invention is

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directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be completely performed by humans, which further illustrate that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the independently claimed apparatus or method including the steps of desirability of associating, page determination to be desirable, inappropriate relative association, or disadvantageously affecting advertisement display is not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed invention specifically reciting those steps is considered non-enabling because the specification does not provide a concrete example or illustrating of those claimed steps. The specification discusses this claimed concept but does not enable one skilled in the art how the steps of desirability of associating, page determination to be desirable, inappropriate relative association, or disadvantageously affecting advertisement display is enabled, based on the specification, such that one would know how to make and/or use the invention. The recited claim terms "desirability," "desirable," "inappropriate," or "disadvantageously" are subjective terms that are considered non enabling to those skilled in the art. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed apparatus or method including the steps of desirability of associating, page determination to be desirable, inappropriate relative association, or disadvantageously affecting advertisement display fail to

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particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps specifically reciting those features are considered indefinite because the claims do not provide an antecedent basis of those steps. The claims discuss this claimed concept but do not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is considered that, as discussed in the specification in light of the claims, the claims are indefinite based on those subjective recitations.. Some of the claims are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include "the desirability" and "the page" – multiple occurrences (claim 1), "the following," "the selected category," and "the page" (claims 10 and 11), "the content" (claim 13), "the following" (claim 14), "the page" and "the current category" – multiple occurrences (claim 15), "the page" – multiple occurrences (claim 17), "the following," "the page" – multiple occurrences, and "the address" (claim 21), "the page" – multiple occurrences (claim 22), and "the following" (claim 26). However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

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Claim R ejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent;

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States;

(c) he has abandoned the invention; or

(e) the invention was described in–

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants' specification to each of the independently claimed inventions. Since the specification background is customarily used as an introduction to admitted prior art while the claims introduce improvements to the admitted prior art, the independently claimed invention mirrors the specification in subject matter and functionality. In this case the claims contain the same subject matter as the specification background and since the background is normally admitted prior art, the claims and claims depending upon them are considered anticipated by the specification admitted prior art. Claims 1-26 are also rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cragun et al. (US 5,504,675), Moore et al. (US 5,630,127), Agrawal et al. (US 5,794,209), Hekmatpour

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(US 5,822,745 or US 5,870,768), Yu et al. (US 5,832,482), Schloss (US 5,878,233), or Robinson (US 5,918,014), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Alberts (US 5,937,392), LeMole et al. (US 6,009,392) or Moraes (US 6,014,502).

Claims 1-26 are further rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An Office search of internet databases revealed that applicant's assignee, specifically International Business Machines Corporation, reveals that the claimed invention has been in public use since at least 1999 (based on financial disclosure statements announcing product developments during that year), which is more than one year from the priority filing date relied upon for the present application.

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: other business ventures regarding the claimed invention in public use as known the applicants and the assignee. Applicants are reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of an apparatus or method for dynamically adapting an advertisement based on page content as provided by completing a consumer product questionnaire, such as those associated with consumer product registration, consumer surveys, or the like. The claimed page content, advertisement, and banner are considered non-functional descriptive material, which will be discussed *infra*. The claimed keyword analyzer, banner display module, and ad server are considered automated features of an old and well known manual operation, which will also be discussed *infra*. The claimed apparatus or method are considered to be patentably equivalent to the examiner receiving a product or survey questionnaire

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related to a consumer product purchase or magazine subscription for targeted advertising based on preference selections made on that questionnaire based on the broadest reading of the claims under the *Graham* decision. Since at least 1994, examiner has experience with the claimed invention as a consumer. The claimed apparatus or method comprising:

- a keyword analyzer for analyzing page content;

- a banner display module for determining the desirability of associating an advertisement with the page; and

- the banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable are part of examiner's personal experience. Examiner's personal experience also includes the claimed first static portion along with a second dynamic portion advertisement display affecting advertiser image, advertiser logo, multimedia file, executable code, or hypertext link, ad server address, proxy router, session information, advertising manager, index repository, current category classification, and domain specific dictionary. The claimed keyword analyzer for analyzing page content is considered functionally equivalent to blocks marked in a product questionnaire such that a later analyzer may use examiner selected information for questionnaire purposes. The claimed banner display module for determining the desirability of associating an advertisement with the page is considered functionally equivalent the examiner questionnaire selections such as interest in swimming, running, cycling, and camping so that the information would allow a banner display module to associate those selections

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with the desirability of outdoor activities, sports, and/or athletic participation for advertisement targeting. The claimed banner display module selectively displaying at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable is considered functionally equivalent to examiner receiving telemarketing calls, postal advertisement mailings, and/or non-automated display of a portion of an advertisement associated with the questionnaire selection page for examiner desired advertisements. The claimed first static portion along with a second dynamic portion advertisement display affecting advertiser image, advertiser logo, multimedia file, executable code, or hypertext link, ad server address, proxy router, session information, advertising manager, index repository, current category classification, and domain specific dictionary are old and well known to those skilled in similar areas of examiner experience and are considered part of consumer questionnaire participation included in examiner's experience. The claimed invention has been performed by the examiner long before the filing of the present invention except for the specifically recited page content, advertisement, and banner. Those recitations are considered non-functional descriptive language and can not be given patentable weight. It would have been obvious to those skilled in the art of the claimed method or system to use those recitations to seek patent protection. The non-functional descriptive language including page content, advertisement, and banner are considered merely information or data item necessary to provide an accounting for establishing and maintaining an information basis in the field of endeavor claimed by the applicant. This non-functional descriptive language difference is only found in the nonfunctional

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descriptive material and is not functionally involved in the steps recited. The claimed page content, advertisement, and banner would be performed the same regardless of the data or information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to claim an apparatus or method particularly page content, advertisement, and banner, because such data or information does not functionally relate to the steps in the invention claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Also, the claimed invention contains automated features, such as keyword analyzer, banner display module, and ad server which are obvious variations to the examiner's experience that is so old and well known that the examiner will use Official notice to obviate that claimed subject matter. The keyword analyzer, banner display module, and ad server, as discussed in the specification, are interpreted to encompass automated electronic communications associated with electronic mail, Internet, and/or computer to server communications. The claimed invention, recited by the applicant, has been provided to examiner by personal experience long before the filing of applicant's invention. Examiner notes that it is old and well known to those skilled in the art of the claimed apparatus or method, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed apparatus or method

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- since those features, particularly keyword analyzer, banner display module, and ad server, are merely automated features of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants' claimed invention with the services offered by consumer product questionnaires, under examiner experience is to allow greater consumer targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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- ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 09/855,090 or are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 09/878,484 or are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending application 09/905,885. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application contains the an obvious variation recitation in claim language as applied to the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,519,557 because the patented plural file reading, multiple hierarchical document generating, and

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- quantitative similarity measurements is an obvious variation to the present application claims including page keyword analysis, module display determination associating advertisement data with the page, and selective banner display for a portion of the data, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,516,312 because the patented automatic query builder including database storage for a domain specific search query string and synchronization of a search engine repository and local query database with summary marker steps are an obvious variation to the present application claims including page keyword analysis, module display determination associating advertisement data with the page, and selective banner display for a portion of the data, or are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,606,644 because the patented real-time communications server connection along with monitoring, retrieving, indexing and summarizing are an obvious variation to the present application claims including page keyword analysis, module display determination associating advertisement data with the page, and selective banner display for a portion of the data. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application contains obvious variant recitations, which are obvious variations of the patented invention features since both comparisons perform the same function, in the same way with the same result.

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Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If**

applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.

Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325



STEPHEN GRAVINI
PRIMARY EXAMINER

smg

September 29, 2003